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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/017,623

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Malcolm Anton McManus Burke

6419

7590

09/15/2004

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EXAMINER

DEBERADINIS, ROBERT L

ART UNIT

PAPER NUMBER

2836

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,623

Applicant(s)

BURKE, MALCOLM ANTON
MCMANUS

Examiner

Robert DeBeradinis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Prosecution on the merits of this application is reopened on claims 1-4 considered unpatentable for the reasons indicated below:

The following rejection is based on new art brought to the Examiner's attention after allowance of this application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
- Claim 1, the specification does not identify any structural elements that perform the function of the means for activating the reverse gear lights. Further the other means of sensate activation are not identified or explained by the specification. Finally, the means to cause the lights to flash or blink are not identified or explained in the specification.

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Claims 2 and 3, the specification does not identify any structure or explain how the switching means is operable only when the vehicle is less than 6 mph.

Claim 3, the specification does not identify any structure or explain how the switching means is operable only when the turn signal is activated.

Claim 4, the specification does not identify any structure or explain how the second activation of a switch will cause the lights to blink.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1:

Lines 1-2 the phrase "means for activating the reverse gear indicator lights" is indefinite

MPEP 2181 states:

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for " or "step for ";
- (B) the "means for " or "step for " must be modified by functional language; and
- (C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function.

And

35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." "If one

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employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc). The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999).

This phrase invokes 112 6th paragraph which requires the specification to identify what structure corresponds to the recited function. The only structure identified in the specification is a vehicle with a reverse gear, a light and a switch or button of some type. Since each of these elements are separately recited in the claim there is no corresponding structure in the specification to render this means plus function claim limitation definite.

Line 2-3, the language in the parenthesis is indefinite. Is this supposed to further limit this claim or not.

Line 3, the redefinition of the switching system to include different elements than those disclosed in the comprising statement (line 1) renders the claim indefinite.

Lines 3-4, the repetition of the means for activation the reverse gear indicator lights is indefinite because it lacks proper antecedent basis.

Lines 5-6 and 7-8, the phrase "or other means of sensate activation" is deemed to invoke 112 6th paragraph and is indefinite because the specification does not identify any structure that performs this function.

Lines 6-7, the phrase “a means of causing the reverse gear ... to flash or blink” is indefinite because the specification does not identify any structure that performs this function.

Claim 2

Line 1, the phrase “the switching means” lacks proper antecedent basis.

Line 2, the use of “third” is improper. In claim 1 the ordinal words first and second were used to introduce structural elements. The use of third here does not introduce a further structural element.

Line 2, there is no structure identified that can perform the function of operable below a preset speed.

Line 3 the phrase “or some other predetermined speed” is indefinite. Either the claim is limited to 6 mph or is not.

Claim 3

Line 1, the phrase “the switching means” lacks proper antecedent basis.

Lines 2-3, the use of “third” or “fourth” is improper. In claim 1 the ordinal words first and second were used to introduce structural elements. Their use here is not related to structural elements.

Line 3 the phrase “or some other predetermined speed” is indefinite. Either the claim is limited to 6 mph or is not.

Line 3-4, there is no structure identified that can perform control based upon the status of the turn indicator switch.

Claim 4 is improper because it refers to claim 1 but does not include all of the limitations of claim 1 because a dependant claim must further limit the claim from which it depends. By not including all of the limitation of claim 1, claim 4 is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by HACHMANN DE 4006771.

Regarding claim 1.

HACHMANN discloses a means for activating the reverse gear indicator lights wherein the switching system includes: first, a means for activating the reverse gear indicator lights while the vehicle is engaged in a forward gear or neutral by means of a button or switch or other means of sensate activation; and second, a means of causing the reverse gear indicator lights, by means of a button or switch or other means of sensate activation, to flash after having been activated (abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over

HACHMANN DE 4006771 A1 in view of LEVINE US 6,502,035.

Regarding claim 2.

HACHMANN discloses the switching system as in claim 1.

HACHMANN does not disclose wherein the switching means is operable only when the vehicle is being operated at a speed of less than 6 mph, or some other predetermined speed.

LEVINE discloses an automotive safety enhancing system wherein acceleration of the vehicle is detected to activate conventional backup lights to alert following drivers of erratic speed changes of the vehicle (column 5, lines 15-30).

It would have been obvious to one having ordinary skill in the art at the time of this invention to select a predetermined speed to activate the switching system. The motivation would be to prevent the activation of the switching system during highway driving which could case a safety incident on the highway.

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Any inquiry concerning this communication should be directed to Robert L. DeBeradinis whose number is (571) 272-2049. The Examiner can normally be reached Monday-Friday from 8:30 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Brian Sircus, can be reached on (571) 272-2058. The Fax phone number for this Group is (703) 872-9306.

RLD

JULY 8, 2004

A handwritten signature in black ink, appearing to read "Robert L. DeBeradinis". The signature is stylized with a large initial "R" and a long horizontal stroke at the end.

ROBERT L. DEBERADINIS
PRIMARY EXAMINER